

REMARKS

Claims 33, 38, and 44 have been amended to clarify what Applicant regards as the invention. Amendments to dependent claims 36-37, 39-43 and 45-49 are to bring these claims in conformity with the language of their respective base claims. No new matter has been added.

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 40 and 41 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 38, from which claims 40 and 41 depend, has been amended to positively recite the occlusive coil device. As such, Applicant respectfully submits that the claim rejections under § 112 have been overcome.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 33, 35, 36, 38-40, 43-47, and 49 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,311,146 (“Wonder”). Claims 33-35, 37-39, 42-46, 48, and 49 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,634,928 (“Fischell”). Applicant respectfully notes that in order to sustain a rejection under §102, each element in the rejected claim must be found, either expressly or inherently, in the cited reference.

Wonder

Claims 33, 38, and 44 each recites an occlusive *coil*. Wonder does not disclose or suggest such a limitation. Rather, Wonder discloses an implantable balloon 110 that can be detached from a catheter 102 (See figures 1-9). There is nothing in Wonder that discloses or suggests implanting an

occlusive coil. As such, claims 33, 38, and 44 are believed allowable over Wonder. For at least the same reason that claims 33, 38, and 44 are allowable over Wonder, claims 35-37, which depend from claim 33, claims 39-43, which depend from claim 38, and claims 45-49, which depend from claim 44, are also believed allowable over Wonder.

Fischell

Claim 33 recites a catheter having a distal section, and an occlusive coil attached to the distal section *such that a distal end of the coil is distal to the distal section*. Fischell does not disclose or suggest such a catheter. Fischell discloses a catheter having a distal section 16 and a stent 40 attached to the distal section 16. However, the distal end of the stent 40 is proximal, and not distal, to the distal section 16 (See figures 4G1, 4G2, and 4H). Particularly, the distal section 16 is required to extend through the stent 40 such that the entire length of the stent 40 can be expanded by the distal section 16, thereby releasing the stent 40 from the catheter. For the foregoing reason, claim 33 and its dependent claims 35-37 are believed allowable over Fischell.

Claims 38 and 44 each recites a system having an occlusive coil and a coupling portion, the coupling portion having a length that is *shorter* than the occlusive coil length. Fischell does not disclose or suggest such a system. Rather, Fischell discloses a system having a stent 40, and a coupling portion 16 that is required to be longer than the stent 40 (See figures 4G1, 4G2, and 4H). As discussed previously, the coupling portion 16 of Fischell must be longer than the stent 40 such that the entire length of stent 40 can be expanded by the coupling portion 16, thereby allowing the stent 40 to be released from the catheter. As such, claims 38 and 44 are believed allowable over Fischell. For at least the same reason that claims 38 and 44 are allowable over Fischell, claims 39-43, which depend from claim 38, and claims 45-49, which depend from claim 44, are also believed allowable over Fischell.


CONCLUSION

Based on the foregoing, all remaining claims are believed in condition for allowance. If, the Examiner has any questions or comments regarding this amendment, please contact the undersigned at the below-listed number.

Respectfully submitted,

Bingham McCutchen LLP

Dated: 1/13/04

By: 
Gerald Chan
Reg. No. 51,541

Bingham McCutchen LLP
Three Embarcadero Center
San Francisco, California 94111
(650) 849-4960